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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	State of Michigan		
Entity	State	Citizenship	Michigan
Address	State Operations Division 525 W. Ottawa - Second Floor Lansing, MI 48933-1067 UNITED STATES		

Attorney information	James L. Scott Warner Norcross & Judd LLP 111 Lyon Street NW 900 Fifth Third Center Grand Rapids, MI 49503 UNITED STATES trademarks@wnj.com, GallagherJ3@michigan.gov, BrickeyD@michigan.gov, RestucciaE@michigan.gov, JacksonJ5@michigan.gov Phone:6167522000
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Registrations Subject to Cancellation

Registration No	3992159	Registration date	07/12/2011
Registrant	Broneah, Inc. 125 E. Front St Traverse City, MI 49684 MI		

Goods/Services Subject to Cancellation

Class 035. First Use: 2007/11/21 First Use In Commerce: 2007/11/21
All goods and services in the class are cancelled, namely: Retail store services featuring clothing, sporting goods, and novelty items

Grounds for Cancellation

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof	Trademark Act section 2(b)
The mark comprises matter that, as a whole, is functional	Trademark Act section 2(e)(5)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.	Trademark Act section 14

Priority and likelihood of confusion		Trademark Act section 2(d)	
The mark is primarily geographically descriptive		Trademark Act section 2(e)(2)	
Other		Registration violates the provisions of the federal Manual on Uniform Traffic Control Devices. http://mutcd.fhwa.dot.gov/kno_2009.htm See 23 USC 109(d), 23 USC 402(c); 23 CFR 655.603(b)(3).	
Registration No	3348635	Registration date	12/04/2007
Registrant	Broneah, Inc. 125 E. Front St Traverse City, MI 49684 MI		

Goods/Services Subject to Cancellation


Class 025. First Use: 2004/01/01 First Use In Commerce: 2004/01/01
All goods and services in the class are cancelled, namely: Apparel specifically hats, t-shirts, long sleeve shirts, sweat shirts, pants, shorts, underwear, tank tops

Grounds for Cancellation

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof	Trademark Act section 2(b)
The mark comprises matter that, as a whole, is functional	Trademark Act section 2(e)(5)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.	Trademark Act section 14

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Design Mark	
Goods/Services	transportation and tourism

Attachments	M22 sign.jpg Petition to Cancel M22.pdf(110050 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/JS/
Name	James L. Scott
Date	12/03/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**



State of Michigan)	
)	
Petitioner,)	Reg. Nos.: 3992159
)	3348635
)	
v.)	
)	
M22, LLC,)	Cancellation No. _____
)	
)	
Registrant.)	
_____)	

CONSOLIDATED PETITION TO CANCEL

Petitioner State of Michigan, by and through its attorneys, Attorney General Bill Schuette, Assistant Attorney General James D. Gallagher, and Special Assistant Attorney General James L. Scott, brings this action to cancel Registration Nos. 3.992,159 and 3348635 owned by Registrant M22, LLC.

Petitioner believes that it has been and will continue to be damaged by the registration of the sign shown in United States Trademark Registrations Nos. 3348635 , registered on December 4, 2007 (the “**M22 Online Registration**”), and 3992159, registered on July 12, 2011 (the “**M-22 Registration**”). Accordingly, Petitioner hereby petitions to cancel the M-22 Registration and the M22 Online Registration on the following grounds:

1. The State of Michigan's highway route marker sign for Michigan

Highway M-22 –  – is identical to the sign  in the M-22 Registration and the M-22 Online Registration (each the “**M-22 Sign**”).

2. Petitioner has used the M-22 Sign continuously in interstate commerce for nearly a century. Petitioner organized its highway system by number in 1919, using the design of a white diamond containing a black letter “M” at the top with the assigned highway number below.¹

3. Petitioner's M-22 highway, designated by the M-22 Sign, is one of the most scenic in Michigan. For over 93 years, generations of travelers have experienced the road and the area immediately surrounding it. The M-22 highway is an integral part of the Grand Traverse Bay area and Northern Michigan region, which is home to some of the most popular destinations for recreation, leisure, and relaxation that Petitioner has to offer.

4. Petitioner is damaged by Registrant's registration of the M-22 Sign and unlawful claims to exclusive rights to use the M-22 Sign.

5. Petitioner's M-22 Sign is not subject to trademark protection.

6. Trademark Manual of Examining Procedure (TMEP) §1205.01 provides:

¹For additional in-depth historical analysis, see Michigan Highways: The Great Routes of the Great Lakes State <<http://www.michiganhighways.org>> (accessed May 8, 2012).

Various federal statutes and regulations prohibit or restrict the use of certain words, names, symbols, terms, initials, marks, emblems, seals, insignia, badges, decorations, medals, and characters adopted by the United States government or particular national and international organizations. These designations are reserved for the specific purposes prescribed in the relevant statute and must be free for use in the prescribed manner.

7. Both federal and state laws establish a uniform system of traffic control devices. In 1971, the United States Department of Transportation, Federal Highway Administration issued regulations designed to bring uniformity to the roadways of the United States pursuant to the Highway Safety Act of 1966. These regulations are set forth in the federal *Manual on Uniform Traffic Control Devices* (“MUTCD”). The MUTCD is the law governing all traffic control devices.

8. The MUTCD is promulgated by the United States Department of Transportation and establishes “the national standard for all traffic control devices installed on any street, highway, or bicycle trail open to public travel,” 23 CFR 655.603(a); 23 CFR Part 655, Subpart F, “in accordance with” 23 USC 109(d) and 23 USC 402(a).² See 23 CFR 655.603.

9. The MUTCD regulates the use of traffic control device designs like Petitioner’s M-22 Sign. The MUTCD provides that the M-22 Sign is in the public domain and not subject to trademark protection:

² 23 USC 109(d) gives the Secretary of Transportation the authority to approve the “location, form and character of informational, regulatory and warning signs, curb and pavement or other markings, and traffic signals” on any highway project involving the use of federal funds. 23 USC 402(a) mandates that each state create “a highway safety program . . . designed to reduce traffic accidents and deaths, injuries, and property damage resulting therefrom” and requires that each state program be “in accordance with uniform guidelines promulgated by the Secretary.”

Any traffic control device design or application provision contained in this Manual shall be considered to be in the public domain. Traffic control devices contained in this Manual shall not be protected by a patent, trademark, or copyright, except for the Interstate Shield and any items owned by [the Federal Highway Safety Administration]. [Emphasis added.]³

10. To remain eligible for federal highway and highway safety program funds, a state must adopt the federal MUTCD as a state regulation, adopt a state MUTCD that is approved by the Secretary of Transportation as being in “substantial conformance” with the federal MUTCD, or adopt the federal MUTCD in conjunction with a state supplement. *See* 23 USC 109(d), 23 USC 402(c); 23 CFR 655.603(b)(3).

11. Consistent with these federal provisions, the Michigan Vehicle Code, 1949 PA 300, MCL 257.1 *et seq.*, requires the Michigan Department of Transportation (“MDOT”) and the Michigan State Police to adopt and maintain a uniform system of traffic control devices,” which includes all signs,⁴ that conforms with the federal MUTCD. *See* MCL 257.608.⁵

12. In compliance with the Michigan Vehicle Code, MDOT has adopted versions of the Michigan MUTCD that are consistent with the federal manual

³ This provision has been part of the Michigan MUTCD since 2005, two years before Registrant’s alleged first use in commerce of the M-22 route marker sign.

⁴ The term “traffic control devices” “means *all signs*, signals, markings, and devices not inconsistent with this act placed or erected by authority of a public body or official having jurisdiction, for the purpose of regulating, warning or guiding traffic.” MCL 257.70 (emphasis added).

⁵ The federal MUTCD is available at <http://mutcd.fhwa.dot.gov/kno_2009.htm> (accessed September 17, 2013).

regarding guidelines on how to create and utilize Michigan traffic control devices.⁶ The federal manual suggests a default design for state highway route markers with a white circle imposed on a black square featuring the respective highway number in black. But it allows states the option to create a unique design, and Michigan chose to maintain its historic design – the M-22 Sign – using a white diamond rather than a circle, and a block “M” over the black number.

13. The M-22 Sign is a traffic control device regulated by the MUTCD.

14. The M-22 Sign is functional in nature and consists of matter that, as a whole, is functional.

15. Under the MUTCD, the M-22 Sign shall not be protected as a trademark.

16. Granting exclusive rights to use the M-22 Sign under the Lanham Act, regardless of associated goods and services, violates the provisions of the MUTCD.

17. When used in association with the goods and services provided by Registrant, the M-22 Sign only imparts information, conveys an informational message, or provides ornamentation.

18. The M-22 Sign fails to function as a mark, is not perceived by consumers as a mark, is not capable of functioning as a trademark, service mark, or trade name, is not perceived by consumers as a source indicator, and when used on

⁶ MDOT’s version of the MUTCD is available at <<http://mdotcf.state.mi.us/public/tands/plans.cfm>> (accessed September 17, 2013).

or in connection with Registrant's goods and services, the M-22 Sign is perceived by consumers as purely ornamental.

19. Registrant's use of Petitioner's M-22 Sign falsely suggests a connection with Petitioner.

20. The M-22 Sign represents and describes the culture of Northern Michigan. That culture is one of recreation and relaxation, vacations, cabins, lakes, Michigan wine, cherry orchards, sand dunes, water sports, skiing, hiking, and similar amenities immediately adjacent to the roadside. This did not happen in three or five years. These associations come from Petitioner's use of the M-22 Sign and maintenance of the highway for travelers for nearly a century.

21. Like other individuals who have travelled the M-22 highway, Registrant's owners "fell in love with M-22, literally while travelling along M-22 countless times in pursuit of wind, waves, and perfect beaches for their beloved sport of kiteboarding. The M-22 image sparked something in the brothers that reminded them of natural beauty, good times, and positive energy[.]"⁷

22. Registrant chose to use the M-22 Sign because of the geographic location it represents and for all that individuals associate with the sign and the highway.

⁷ See Exhibit A to USPTO Trademark Application No. 85041051, a copy of the M-22 Website, About Us, available at <<http://m22.com/about-us>> (accessed September 16, 2013).

23. Registrant chose to use the M-22 Sign because of the sign's association with Northern Michigan and the "natural beauty, good times, and positive energy" there.⁸

24. Registrant's predecessor, Broneah, Inc., was formed by its owners to "express a common passion for Northern Michigan." [Emphasis added].⁹

25. Travelers to and within the State of Michigan associate the M-22 Sign with the State of Michigan.

26. The experience and culture surrounding the highway give the M-22 Sign its significance and create the impression that consumers associate with the M-22 Sign.

27. Registration of the M-22 Sign is improper under Section 2(a) of the Lanham Act, 15 USC § 1052(a), as it falsely suggests a connection with the State of Michigan.

28. Registration of the M-22 Sign is improper under Section 2(b) of the Lanham Act, 15 USC § 1052(b), as it consists of insignia of the State of Michigan.

29. The M-22 Sign is primarily merely geographically descriptive.

30. The M-22 Sign in the M-22 Registration and in the M-22 Online Registration is functional.

⁸ *Id.*

⁹ *Id.*

31. The M-22 Sign in the M-22 Registration and in the M-22 Online Registration is being used by Registrant to misrepresent the source of the goods or services on or in connection with which the mark is used.

32. The M-22 Registration and the M-22 Online Registration were obtained fraudulently.

33. Registrant knowingly misrepresented facts regarding the significance of the M-22 Sign in obtaining the M-22 Registration and the M-22 Online Registration.

34. The M-22 Registration and the M-22 Online Registration were obtained contrary to the provisions of 15 U.S.C. § 1052 (a) and (b).

35. Petitioner's State Highway M-22 is a picturesque and well-traveled 116-mile drive along Lake Michigan through Manistee, Benzie, and Leelanau Counties. A 64 mile segment of M-22 in Leelanau County has been designated a Michigan Scenic Heritage Route under 1993 PA 69, MCL 247.951 et seq. The "heritage route" designation may be applied to "[c]ertain portions of the state trunkline highway system [that] are so uniquely endowed by natural aesthetic, ecological, environmental, and cultural amenities immediately adjacent to the roadside that their use by a larger percentage of the motoring public, particularly during the recreational season, is for the experience of traveling the road rather than as a route to a destination." MCL 247.953.

36. In the 93 years in which the M-22 Sign has been used by Petitioner, travelers have come to associate the M-22 Sign with those “natural aesthetic, ecological, environmental, and cultural amenities immediately adjacent to the roadside . . .” Likewise, the M-22 Sign has long been, and continues to be, associated with Petitioner and Northern Michigan.

37. Registrant acknowledges that “M-22 is not just a road; it is a way of life.”¹⁰

38. Registrant has acknowledged that “[M-22] is marked by the simplicity and appreciation for natural wonders such as bays, beaches, and bonfires, dunes and vineyards, cottages, friends and family everywhere.”¹¹

39. When used on or in connection with Registrant’s goods, the M-22 Sign is merely descriptive of them.

40. When used on or in connection with Registrant’s goods, the M-22 Sign is primarily merely geographically descriptive of them.

41. The Michigan route marker design is not subject to copyright protection because it is in the public domain.

42. Registrant’s registration of the M-22 Sign and claim to exclusive rights in the M-22 Sign improperly circumvents copyright law.

43. Granting exclusive rights to use the M-22 Sign under the Lanham Act, regardless of any associated goods and services, circumvents copyright law. See

¹⁰ *Id.*

¹¹ *Id.*

Dastar Corp v Twentieth Century Fox Film Corp, 539 US 23, 34; 123 S Ct 2041; 156 L Ed 2d 18 (2003). See also *Comedy III Productions, Inc v New Line Cinema*, 200 F3d 593, 595; 53 USPQ2d 1443 (CA 9, 2000) (“[T]he Lanham Act cannot be used to circumvent copyright law. If material covered by copyright law has passed into the public domain, it cannot then be protected by the Lanham Act without rendering the Copyright Act a nullity”).

44. As stated above, the MUTCD provides that the M-22 Sign is in the public domain and not subject to trademark *nor copyright* protection:

Any traffic control device design or application provision contained in this Manual shall be considered to be in the public domain. Traffic control devices contained in this Manual shall not be protected by a patent, trademark, or copyright, except for the Interstate Shield and any items owned by [the Federal Highway Safety Administration]. [Emphasis added.]¹²

45. Registrant cannot protect the M-22 Sign under copyright law because it took no part in creating it. Registrant has commandeered the design and seeks to usurp copyright law by obtaining trademark protection over a design that is in the public domain.

¹² This provision has been part of the Michigan MUTCD since 2005, two years before Registrant’s alleged first use in commerce of the M-22 Sign.

For the reasons stated above, Petitioner respectfully requests that Registrations Nos. 3,348,635 and 3,992,159 be cancelled.

By _____

Date: December 3, 2013

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of this Petition for Cancellation has been served on the owner of record, M22, LLC, by mailing a copy on December 3, 2013, via First Class Mail, postage prepaid to the following correspondence address of record:

M22, LLC
125 E. Front Street
Traverse City, Michigan 49684

